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OFFICE OF PETITIONS

In re Application of	:	
South et al.	:	DECISION ON APPLICATION
Application No. 09/717,051	:	FOR
Filed: November 20, 2000	:	PATENT TERM ADJUSTMENT
Atty Docket No. C-3204/2	:	

This is a decision on the "PETITION FOR APPLICATION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR § 1.705(b)" filed June 16, 2005. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred forty-eight (148) days to seven hundred ninety-seven (797) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is seven hundred ninety-seven (797) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On May 23, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 148 days. On June 16, 2005, applicants timely¹ submitted an application for patent term adjustment (with required fee). Applicants state that the patent term adjustment should be based on a period of adjustment of 829 days for Office

¹ PALM records indicate that the Issue Fee payment was also received on June 16, 2005.

delay reduced by 32 days for applicant delay. Applicants, in effect, dispute the additional reduction of 649 days for applicant delay.

Applicants state that a terminal disclaimer has not been filed in this application.

Applicants are correct. A review of the record reveals that the reduction of 649 days is not warranted. A change of correspondence address was filed on March 6, 2001. However, the original Notice to File Missing Parts of Application mailed April 27, 2001, was mailed to the pre-March 2001. Furthermore, multiple status inquiries, referencing the change of address, were filed in this application. Subsequently, on March 5, 2003, the Notice to File Missing Parts of Application was re-mailed and the period for reply reset. Further, applicants' response is of record in the application with a date of receipt by the Office of May 7, 2003. Furthermore, the response included a complete reply to the Notice. Under the circumstances of this case, the mailing date of March 5, 2003 (not April 27, 2001) should be used to assess applicant delay in responding to the Notice to File Missing Parts. As such, the response was filed within the three-month period under 37 CFR 1.704(b). Applicants did not fail to engage in reasonable efforts to conclude prosecution of the application by delaying in replying to the Notice to File Missing Parts of Application mailed March 5, 2003.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is seven hundred ninety-seven (797) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office of Patent Publication has been advised of this decision. The Office has, thereby, forwarded the file to the Office of Patent Publication so that a patent can be issued. The patent term adjustment indicated on the patent will include any additional patent term accrued for Office delay in issuing the patent after the issue fee had been paid and all outstanding requirements met.

Petitioner is reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period

during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004).

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.



Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen